

No. 87-515

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In the Supreme Court of the United States

OCTOBER TERM, 1987

UMC ELECTRONICS COMPANY, PETITIONER

v.

UNITED STATES OF AMERICA

ON PETITION FOR A WRIT OF CERTIORARI TO
THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

BRIEF FOR THE UNITED STATES IN OPPOSITION

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QUESTION PRESENTED

Whether petitioner's patent is invalid under 35 U.S.C. 102(b), which denies patentability to an invention that has been on sale for more than one year prior to the filing date of the patent application, where petitioner offered to sell its invention more than one year before applying for a patent, and at the time it did so it was convinced, based on tests performed on a prototype, that the invention would work for its intended purpose, although the prototype was not identical to the invention in every respect.

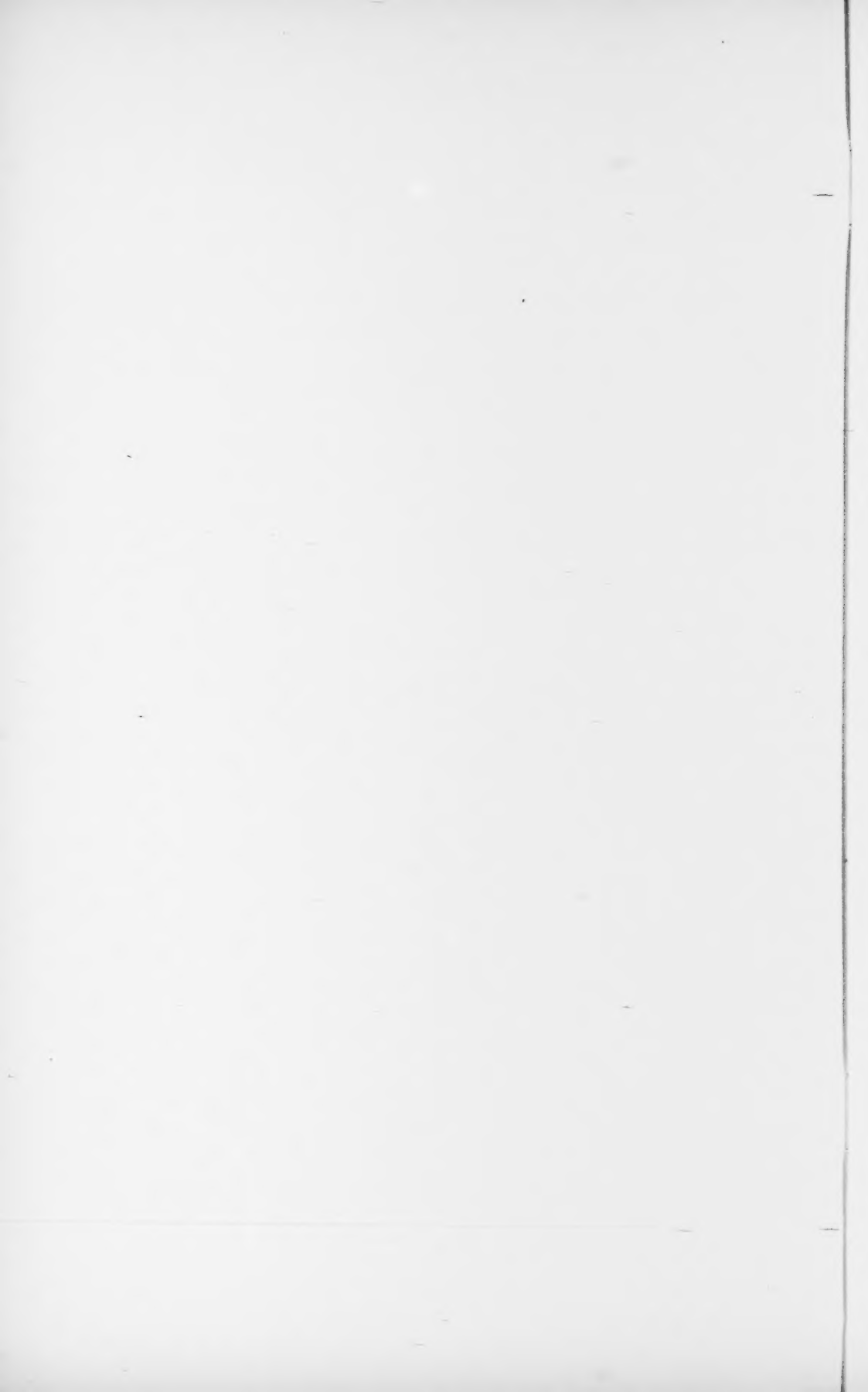


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OPINIONS BELOW

The opinion of the Federal Circuit (Pet. App. A1-A41) is reported at 816 F.2d 647. The opinion of the United States Claims Court (Pet. App. A42-A82) is reported at 8 Cl. Ct. 604.

JURISDICTION

The judgment of the court of appeals (Pet. App. A84) was entered on April 15, 1987. A petition for rehearing was denied on June 29, 1987 (Pet. App. A85), and the suggestion for rehearing en banc was declined on July 14, 1987 (Pet. App. A86). The petition for a writ of certiorari was filed on September 28, 1987. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

STATEMENT

1. This is a suit by petitioner, UMC Electronics Company, against the United States to recover compensation

for the use of its patented invention (Patent No. 3,643,513), an aircraft counting accelerometer (ACA). The claimed invention, which petitioner owns by assignment from the inventor, Preston Weaver, is a device that senses and records the number of times an aircraft has undergone predetermined levels of acceleration. The sensor component is mounted on the aircraft and is connected electrically to the recorder components. Information obtained by the device can reveal an aircraft's remaining useful life and indicate its need for inspection, maintenance, or rotation to other service. Pet. App. A1-A3, A43.¹

The patent application for petitioner's device was filed on August 1, 1968 (Pet. App. A3). Under 35 U.S.C. 102(b), a person is entitled to a patent unless, *inter alia*, "the invention was * * * on sale in this country, more than one year prior to the date of the application for patent in the United States * * *." Thus, petitioner's actions—and the progress of Weaver's invention—during the period preceding August 1, 1967, are critical to the issue whether the device is subject to the on-sale bar.

¹ The device differs from prior ACAs in that it uses an analog transducer rather than a mass-spring transducer (Pet. App. A4). An analog transducer generates an electrical signal proportional to the acceleration experienced by the aircraft on which the device is mounted (*id.* at A45-A46). Analog transducers of the type used in the patented invention were well-known in the prior art (*id.* at A4 n.3, A58). A mass-spring system uses electromechanical transducers to generate mechanical signals (*id.* at A43). The problem with the mass-spring system was that it could not distinguish between acceleration resulting from inflight maneuvers (which determines stress on the aircraft) and vibrations resulting from other sources, such as wind gusts (*id.* at A4, A43). The analog transducer solves that problem by generating a varying electrical signal that can be filtered to remove the effects of irrelevant vibrations (*id.* at A4, A43-A44).

In 1966, the United States Navy contacted Weaver, who was one of petitioner's employees, and indicated that it was unhappy with the ACAs that it had procured from other companies. In response to the Navy's concerns, Weaver designed a somewhat improved ACA,² and in July 1966 petitioner was awarded a contract to supply the Navy with approximately 1600 units. Pet. App. A3.

In early 1967, petitioner determined that its ACA would not meet the Navy's specifications. To prevent petitioner from losing the contract, Weaver began working on an improved model, and he eventually conceived the idea of using an analog transducer. In April or May 1967, Weaver built a prototype of his ACA that contained "a commercial analog transducer, a filter, a timing circuit and a voltage sensor that measured one load level." Pet. App. A4.

In May 1967, the Navy issued new specifications for ACAs. Two months later it requested proposals to deliver ACAs under the new specifications. Petitioner responded to the request on July 27, 1967, the final date for submitting a response, with an offer to supply \$1,668,743 worth of improved ACAs. In its proposal, petitioner represented that the sensor portion "has been constructed and tested in conjunction with voltage sensing and time controlled circuitry." Pet. App. A5. On August 2, 1967, petitioner responded to a Navy inquiry by submitting a technical proposal that described the ACA in detail and contained test results and diagrams (*id.* at A5, A45). On August 9, 1967, petitioner gave a demonstration to the Navy of the prototype that Weaver had constructed (*ibid.*). The prototype differed from the device actually offered to the Navy, but not in any significant way.³ Indeed, Weaver

² This ACA, like the others in the industry, used a mass-spring transducer (Pet. App. A3-A4).

³ Specifically, the prototype differed from the claimed invention in two respects. First, the prototype did not contain electromagnetic

admitted at the trial in this case that he “could satisfy the Navy’s requirements” because he was sure, based on the prototype, that the invention was feasible and would work as conceived (*id.* at A65-A66; see also *id.* at A22). The Navy subsequently canceled the request for proposals without entering into a contract with petitioner.

In July 1968, the Navy issued another invitation for bids. That invitation ultimately resulted in a contract with another company, Systron-Donner Corporation, which since 1970 has been supplying the Navy with ACAs using analog transducers. Petitioner has never produced the ACA disclosed in the Weaver patent. Pet. App. A5, A45.

2. In June 1980 petitioner filed suit against the United States, claiming that Systron-Donner’s ACA infringed the Weaver patent and that the United States was therefore required to compensate petitioner for the use of that ACA. The Claims Court upheld the validity of the Weaver patent and held that the on-sale bar did not apply but dismissed the case on the ground that Systron-Donner’s ACA did not infringe that patent (Pet. App. A42-A82).⁴

counters, which advance one count whenever a load level has been exceeded. Counters identical to those used in the Weaver invention were a common part of prior ACAs, including one made by petitioner. Pet. App. A46, A48-A53, A57. Second, the prototype had only one load level rather than multiple load level channels. As we explained below (Gov’t C.A. Br. 35 n.10), however, the use of more than one load level was well known in the art. Indeed, petitioner’s description of its device in its July 27, 1967, offer for sale specified a plurality of load levels (see Gov’t C.A. Br. Supp. App. A1 (excerpt from proposal)); see generally Gov’t C.A. Br. 36 (diagram showing differences between prototype and claimed invention).

⁴ A four-day trial was held before a Claims Court judge, who retired without rendering findings of fact and conclusions of law. The parties waived a new trial and submitted post-trial briefs. Another Claims Court judge heard oral argument and decided the case based on the briefs and the trial record. Pet. App. A42.

In considering the on-sale issue, the Claims Court noted that petitioner offered to sell its ACAs to the Navy on July 27, 1967, and that it did not apply for a patent until August 1, 1968, more than a year later (Pet. App. A63). The court further noted that the offer to the Navy was for profit, not for experimental purposes (*id.* at A64). The court indicated that "reduction to practice" was a prerequisite to the on-sale bar (*ibid.*), but it indicated that this requirement is satisfied if an invention is " 'sufficiently tested to demonstrate that it will work for its intended purpose' " (*id.* at A65 (citations omitted)). Based on Weaver's trial testimony, the court held that the testing of the prototype "reduced [the] invention to practice, because [the tests] demonstrated that his invention would serve its intended purpose" (*id.* at A65). The court further held, however, that the on-sale bar did not apply because the prototype did not include every element of the invention. The court acknowledged that, under Federal Circuit case law, a physical embodiment of the item was not a prerequisite to the on-sale bar in every case, but it held that such a requirement should be imposed here because petitioner "reaped no commercial benefits before the statutory period." *Id.* at A66. Nonetheless, the court dismissed the lawsuit, holding that the Systron-Donner ACA was substantially different from petitioner's ACA and that, accordingly, the United States had not used the patented invention (Pet. App. A70-A82).

3. Both parties filed appeals; petitioner challenged the finding of no infringement, and the United States challenged the finding that the Weaver patent was valid. The Federal Circuit held that the offer for sale to the Navy in July 1967 invalidated the patent (Pet. App. A1-A22). The court first held that the Claims Court erred in concluding that the invention was reduced to practice. It noted that "reduction to practice" was "a term of art"

developed in the context of interference law (*id.* at A16),⁵ and that under Federal Circuit precedent, reduction to practice requires “a physical embodiment which includes all limitations of the claim” (*id.* at A9). That requirement, the court concluded, had not been satisfied here (*ibid.*). The court further concluded, however, that the absence of strict reduction to practice did not resolve the issue of the patent’s validity. It indicated that the government’s contention was that petitioner’s “substantial attempted commercial exploitation of the claimed invention contravenes the policies of the on-sale bar despite the absence of a complete embodiment and, thus, raises an on-sale bar under section 102(b)” (*ibid.*). Resolution of that issue, the court reasoned, required a determination whether reduction to practice is invariably required to invoke the on-sale bar (*ibid.*).

To answer that question, the Federal Circuit examined its precedents and those of other courts (Pet. App. A9-A20). The court indicated (*id.* at A14-A15) that the Federal Circuit had never “taken a definitive position either way” (*id.* at A15). Indeed, the court noted, in one prior case the Federal Circuit “went out of its way to reserve the question whether a physical embodiment should be a requirement of the on-sale bar in all cases” (*id.* at A12, citing *Barmag Barmer Maschinenfabrik AG v. Murata Mach., Ltd.*, 731 F.2d 831, 836-837 (Fed. Cir. 1984)). See also Pet. App. A10-A11 (citing *General Electric Co. v. United States*, 654 F.2d 55 (Ct. Cl. 1981), as another case in which the issue had been left open). The court further noted (Pet. App. A16) that, while the

⁵ An interference proceeding is an action within the Patent and Trademark Office to determine which among competing patent applicants was the first inventor of a particular device. Unlike 35 U.S.C. 102(b), the statute governing interference (35 U.S.C. 102(g)) explicitly incorporates reduction to practice as an element for determining the priority of an invention.

regional circuits had generally stated that reduction to practice was required for the on-sale bar to apply, "when faced with a specific factual situation which appeared to fall within the intent of the statutory bar but did not technically satisfy the requirements for reduction to practice, these courts have stepped back from a rigid application of that requirement." Rather, they have "looked to see whether the invention was 'sufficiently' reduced to practice for purposes of the bar" (*ibid.* (citation omitted)).

The court refused to adopt a "sufficiently" reduced to practice standard, however, noting that such an approach would be "an abandonment of reduction to practice as that term is used in other contexts" (Pet. App. A16). The court indicated (*ibid.*) that a holding here "that there can be a reduction to practice without an embodiment containing all elements of the claim would have a major unintended impact on interference law" (*id.* at A17). The court further noted, however, that the application here of the strict definition used in interference law would undermine Section 102(b) because "an inventor might be able to escape the on-sale bar simply through deft claim draftsmanship" (Pet. App. A17 (citing examples)).

The court emphasized that it did "not intend to sanction attacks on patents on the ground that the inventor or another offered for sale, before the critical date, the mere concept of the invention," and it pointed out that inventors should not "be forced to rush into the Patent and Trademark Office prematurely" (Pet. App. A19). On the other hand, it rejected petitioner's contention "that as a matter of law no on-sale bar is possible unless the claimed invention has been reduced to practice in the interference sense" (*ibid.*).

The court noted that "reduction to practice," while not dispositive, is "an important analytical tool in the on-sale analysis," and a finding one way or the other on that issue might in some cases determine whether the bar should

apply (Pet. App. A19). It stated, however, that “the on-sale bar does not necessarily turn on whether there was or was not a reduction to practice of the claimed invention,” and that “[a]ll of the circumstances surrounding the sale or offer to sell, including the stage of development of the invention and the nature of the invention, must be considered and weighed against the policies underlying section 102(b)” (*ibid.*).

The court held that in the present case, the on-sale bar applied (Pet. App. A21-A22). Petitioner offered to sell its ACA more than one year prior to the date of its patent application, and the offer was for profit, not for research and development (*id.* at A21). Moreover, the development of the invention “was far beyond a mere conception” because “[m]uch of [it] was embodied in tangible form” (*id.* at A22). In particular, “[t]he prior art devices embodied each element of the claimed invention, save one, and that portion was available and had been sufficiently tested to demonstrate to the satisfaction of the inventor that the invention as ultimately claimed would work for its intended purpose” (*ibid.*). These facts, the court held, rendered the patent invalid under Section 102(b).

Judge Smith dissented (Pet. App. A23-A41). In his view, the Federal Circuit had previously adopted reduction to practice as an essential element in the application of the on-sale bar (*id.* at A33-A38 (discussing cases)). He believed that, as a result of the court’s decision, inventors would have to file “paper patents”—*i.e.*, “patents on sketchy concepts, before they have been reduced to practice and before the inventor knows whether or how the invention will work, or whether it is worth developing” (*id.* at A39).

Petitioner subsequently filed a petition for rehearing and suggestion for rehearing en banc, making essentially the same arguments that it makes in this Court. The American Intellectual Property Law Association (AIPLA)

filed an amicus brief in support of the rehearing petition. On June 29, 1987, the court denied rehearing, and on July 14, 1987, the court declined the suggestion for rehearing en banc (Pet. App. A85, A86). Apart from Judge Smith, only one judge voted in favor of en banc rehearing (*id.* at A86).

ARGUMENT

The court of appeals correctly held that petitioner's patent was invalid under 35 U.S.C. 102(b). Petitioner offered to sell its invention more than one year before it applied for a patent, and at the time the offer was made, the inventor was convinced, based on tests performed on the prototype, that the device would work as intended. In these circumstances, a strict requirement of "reduction to practice," as defined and applied in interference law, would undermine the purposes of the on-sale bar. Furthermore, while there is conflicting language in some prior decisions by the Federal Circuit and other circuits, the holding in the present case does not represent a departure from prior case law. Accordingly, review by this Court is not warranted.

1. Under 35 U.S.C. 102(b), an inventor is not entitled to a patent if "the invention was * * * on sale in this country, more than one year prior to the date of the application for patent in the United States." One of the "primary purposes" of the on-sale bar is "to preclude commercial exploitation of an invention which has the effect of expanding the period of exclusive rights granted by the statute." *Barmag Barmer Maschinenfabrik AG v. Murata Mach., Ltd.*, 731 F.2d 831, 836 (Fed. Cir. 1984). Without such a bar, an inventor would "have the best of two worlds" because he could then "commercially exploit his invention without disclosing it for an indefinite amount of time before he applied for a patent, giving him an additional seventeen years of exclusive rights." Note, *New Guidelines for Applying the On Sale Bar to Patentability*, 24 Stan. L.

Rev. 730, 734 (1972). The on-sale bar therefore "forces the inventor to choose between seeking patent protection promptly after sale or taking his chances with his competitors and losing his right to a patent" (*ibid.*). See generally *Pennock v. Dialogue*, 27 U.S. (2 Pet.) 1, 18 (1829).

Apart from its requirement that the period between the sale and the patent application may not exceed one year, Section 102(b) does not specify the precise elements for determining when the on-sale bar should be invoked. Significantly, unlike Section 102(g), it does not explicitly require that the invention be reduced to practice.⁶ The reference to reduction to practice in Section 102(g) but not in Section 102(b) strongly supports the Federal Circuit's holding that reduction to practice is not an indispensable element of Section 102(b). See, e.g., *Rodriguez v. United States*, No. 86-5504 (Mar. 23, 1987), slip op. 4 (quoting *Russello v. United States*, 464 U.S. 16, 23 (1983) (noting that "[w]here Congress includes particular language in one section of a statute but omits it in another section of the same Act, it is generally presumed that Congress acts intentionally and purposely in the disparate inclusion or exclusion'")).

To be sure, the legislative history indicates Congress's recognition that an invention should be "fully completed" for the on-sale bar to apply. See Pet. 9 (quoting legislative history of 1939 statute). But that statement does not suggest that "fully completed" is synonymous with "reduction to practice." The concern regarding the completeness of the invention is that the device will work as intended. Yet,

⁶ Section 102(g) provides that a person is not entitled to a patent if the invention was previously made (and not abandoned or concealed) by someone else. It specifies that "[i]n determining priority of invention there shall be considered not only the respective dates of conception and *reduction to practice* of the invention, but also the reasonable diligence of one who was first to conceive and last to *reduce to practice*, from a time prior to conception by the other" (emphasis added).

where this is known from tests performed on a prototype, the invention is clearly complete in the sense that Congress intended. As one court has noted, “[e]xact identity is not required as long as the invention is essentially completed at the time of the invalidating sale.” *Dart Industries, Inc. v. E.I. Du Pont De Nemours & Co.*, 489 F.2d 1359, 1365 (7th Cir. 1973) (footnote omitted), cert. denied, 417 U.S. 933 (1974). In fact, requiring exact identity would frustrate Congress’s intent, since the inventor would be able to reap substantial commercial benefits outside the one-year period by marketing a product that varies in only a technical or insubstantial way from the one for which a patent is sought. See *Barmag*, 731 F.2d at 837.

Numerous courts, while acknowledging that reduction to practice should be a factor in determining whether there is an on-sale bar, have indicated that an exact physical embodiment of the invention is not required. See, e.g., *Red Cross Mfg. Corp. v. Toro Sales Co.*, 525 F.2d 1135, 1141 (7th Cir. 1975) (noting that the issue is whether “the item placed ‘on sale’ sufficiently embodied the invention” and that “[e]xact identity” is not required if “the invention is essentially completed at the time of the invalidating sale”); *Dart Industries, Inc.*, 489 F.2d at 1365 (invention need only be “essentially completed” or “sufficiently” reduced to practice); *Farrand Optical Co. v. United States*, 325 F.2d 328, 333, 334 (2d Cir. 1963) (applying a “sufficiently reduced to practice” test and noting that “[t]he essential inquiry” was whether the invention “was embodied in a workable device that demonstrated that it could do what it was claimed to be capable of doing”); *Langsett v. Marmet Corp.*, 231 F. Supp. 759, 766-770 (W.D. Wis. 1964) (window frame invention reduced to practice even though prototype not completed, since architects were confident enough in the inventor’s explanation of it to adopt it in blueprints for a building).

In the present case, the court of appeals used somewhat different language, but the result it achieves is essentially the same as a “substantial” reduction to practice approach. The court’s concern was that since the concept of “reduction to practice” had a fixed meaning in interference law (35 U.S.C 102(g)), a holding that an invention could be “reduced to practice” for purposes of Section 102(b) before there was a complete physical embodiment of it would cause confusion in the context of Section 102(g). On the other hand, the court also recognized that a strict application of reduction to practice under Section 102(b) would enable inventors to escape the on-sale bar by relying on mere technicalities. Pet. App. A17. Thus, instead of defining “reduction to practice” to permit “substantial” similarity between the prototype and the invention, the court adhered to the rigid definition used in interference law, but held that reduction to practice is not invariably required under Section 102(b) (Pet. App. A17-A20). The court’s approach—which recognizes the possible spillover consequences of defining reduction to practice in a flexible manner—is eminently sound and entirely consistent with the text and purposes of Section 102(b).⁷

2. Petitioner contends that the present case conflicts with prior Federal Circuit authority (Pet. 10-11).⁸ But

⁷ In addition, the court’s approach preserves the strong incentive Section 102(g) gives inventors to reduce their inventions to practice. It does so by both (a) adhering to a strict definition of “reduction to practice” and (b) denying the inventor the opportunity to avoid the on-sale bar by deliberately stopping short of full reduction to practice.

⁸ Petitioner does not claim that this Court has ever held that reduction to practice is an absolute requirement in the application of the on-sale bar. It states, however, with no analysis, that “this Court’s early

apart from the fact that such a conflict would be for the Federal Circuit, not this Court, to resolve, petitioner's claim lacks merit. As the court below explained, after conducting a detailed examination of prior Federal Circuit authority, it "cannot be said that this court has taken a definitive position either way on the issue we address here" (Pet. App. A15). And despite petitioner's claim below that the present case creates an intra-circuit conflict (UMC Pet. Rehearing 6-10), only two judges voted to rehear the case en banc.⁹

In addition, petitioner (Pet. 10) and AIPLA (AIPLA Br. 8) contend that the court's opinion conflicts with decisions of other circuits. But as the court below explained (Pet. App. A16), while the circuits have stated on

decisions * * * implied such a rule" (Pet. 10 (citing *Andrews v. Hovey*, 123 U.S. 267 (1887), and *Elizabeth v. Pavement Co.*, 97 U.S. 126 (1878))). We find no such implication in those cases. If anything, this Court's decisions imply the contrary. See, e.g., *Hall v. Macneale*, 107 U.S. 90, 97 (1882) (finding invention complete because "[i]t was capable of producing the results sought to be accomplished"); cf. *Corona Cord Tire Co. v. Dovan Chemical Corp.*, 276 U.S. 358, 373-374 (1928).

⁹ The principal case relied upon by petitioner (Pet. 10-11, 15)—*State Industries, Inc. v. Mor-Flo Industries, Inc.*, No. 86-1452 (Mar. 3, 1987), cert. denied, No. 87-11 (Oct. 5, 1987) (unpublished decision, not to be cited as precedent, reproduced at Pet. App. A87-A93)—does not come close to raising the intra-circuit conflict it alleges. In *Mor-Flo*, the defendant failed to establish that a product produced by the patented process was even put on sale (Pet. App. A92). Furthermore, the device that had been tested at the time of the alleged offer for sale lacked a critical element and the testing was not sufficient to demonstrate that the invention would work for its intended purpose (*id.* at A93). By contrast, as noted above, petitioner's prototype lacked only insignificant elements and its testing was found sufficient to prove that the invention would function as intended. Indeed, the focus in *Mor-Flo* on whether the invention would function as intended confirms that it is adequacy of testing, not technical reduction to practice, that is critical in determining whether an invention was complete at the time of an offer for sale.

several occasions that reduction to practice is required to invoke the on-sale bar, they "have stepped back from a rigid application of that requirement" when confronted "with a specific factual situation which appeared to fall within the intent of the statutory bar but did not technically satisfy the requirements for reduction to practice." Instead, they have "looked to see whether the invention was 'sufficiently' reduced to practice for purposes of the bar" (*ibid.* (citation omitted)). See cases cited on page 11, *supra*. Petitioner fails to cite a single case with facts similar to those here in which a court has refused to invoke the on-sale bar because the invention was not reduced to practice.¹⁰

In any event, since the Federal Circuit now has exclusive jurisdiction in patent cases (see 28 U.S.C. (& Supp. III) 1295(a)), the approach taken by other circuits in prior years, even if it were not entirely consistent with the

¹⁰ Petitioner cites several cases for the proposition that "every United States Court of Appeals to consider the question had held that reduction to practice was required" (Pet. 10). In many of the cases, however, the language is simply dictum. Moreover, many of the courts do not define what they mean by "reduction to practice." And several of the cases actually undermine petitioner's claim. *E.g.*, *Dataq, Inc. v. Tokheim*, 736 F.2d 601, 604-605 (10th Cir. 1984) (reduction to practice characterized as a "factor" in determining whether an invention is complete); *DeLong Corp. v. Raymond Int'l, Inc.* 622 F.2d 1135, 1141 (3d Cir. 1980) (citations omitted) (stating that a reduction to practice does not occur " 'until the inventor has sufficiently tested the prototype to prove its utility and to determine that no further refinements are necessary' "); *In re Yarn Processing Patent Validity Litigation*, 498 F.2d 271, 280 (5th Cir.) (reduction to practice requires "sufficient testing or experimentation to demonstrate that the device as it exists possesses sufficient utility to justify a patent, *i.e.*, that the invention is suitable for its intended purpose"), cert. denied, 419 U.S. 1057 (1974).

Federal Circuit's approach, would not result in any lack of uniformity. Accordingly, further review is not necessary to resolve the purported inter-circuit conflict.

3. Finally, petitioner (Pet. 7) and AIPLA (Br. 3-7) claim that the court's decision will cause confusion and uncertainty among inventors and will hamper experimentation. That contention is erroneous for several reasons. First, as explained above, numerous courts have in fact applied a "substantial" reduction to practice test; petitioner and AIPLA therefore err in suggesting that, prior to the present case, inventors were safe in concluding that the on-sale bar would not apply in the absence of an exact prototype of the invention, even where, as here, the inventor knew from testing the prototype that the invention would work as intended. Second, the court below underscored that its decision was a narrow one that would not impose an on-sale bar if the inventor merely had a concept of an invention (Pet. App. A19, A20). Indeed, the court drew a sharp distinction between commercial exploitation, which was involved here, and sales for experimental purposes (*id.* at A21). And the court emphasized, contrary to AIPLA's claim (Br. 5), that inventors will not be forced, as a result of this case, to file patent applications prematurely (Pet. App. A19). Thus, the various concerns expressed by petitioner and AIPLA about the need for adequate experimentation are simply inapposite. Third, the court did not completely abandon the reduction to practice standard in this context. To the contrary, it emphasized that reduction to practice remained "an important analytical tool in on-sale analysis" (*ibid.*). The court simply held that strict reduction to practice, as applied in interference law, did not apply where, as here, the inventor knew from testing the prototype that the invention would work as intended, and where, more than a year

prior to filing for a patent, petitioner offered to produce more than \$1.6 million worth of the ACAs for commercial purposes (*id.* at A5, A22)¹¹

In sum, contrary to petitioner's and AIPLA's contentions, the present case does not represent a dramatic departure from prior law. Where an inventor has merely conceived his invention but has not yet conducted adequate testing, he need not worry about the on-sale bar. Petitioner's and AIPLA's purported concerns about the impact of the court's decision are at best speculative. There is no reason to assume that the decision will lead to confusion or unfairness in future cases. Absent a clear need for this Court to intervene, which has not been demonstrated here, the adjudication of patent law issues should be left to the Federal Circuit, which was given that task by Congress.

CONCLUSION

The petition for a writ of certiorari should be denied.
Respectfully submitted.

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DECEMBER 1987

¹¹ Petitioner errs in suggesting (Pet. 13-14) that the on-sale bar does not apply to mere *offers* to sell. It is well established that an offer prior to the critical date gives rise to an on-sale bar, regardless of the date of delivery. See *In re Theis*, 610 F.2d 786, 791-792 (C.C.P.A. 1979) (citing cases).

